



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,223	12/21/2004	Georg Gros	DNAG-293	2138
24972 7590 06/10/2009 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198				
EXAMINER				
VDAYAKUMAR, KALLAMBELLA M				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
06/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/511,223

**Applicant(s)**

GROS, GEORG

**Examiner**

KALLAMBELLA VIJAYAKUMAR

**Art Unit**

1793

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 141-177 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 141-154, 156-171 and 173-177 is/are allowed.
- 6) ☒ Claim(s) 155 and 172 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

Art Unit: 1793

#### DETAILED ACTION

- A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/27/2009 has been entered.
- Applicant's amendment filed 08/14/2008 has been entered. Claims 141, 155 and 172 were amended. Claims 141-177 as amended are currently pending with the application.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 155 and 172 are rejected under 35 U.S.C. 103(a) as obvious over Campbell (US 4,794,050).

Campbell teaches a coating composition comprising a binder, a phosphide pigment and the pigment containing up to 40 wt% of an additional metal such as Sn, Al or Pb (Abstract). The pigment comprised from about 30% to 90% of the non-volatile components (CI-3, Ln 38-43). The binder comprised of 5%-96% of the non-volatiles, and preferably 10%-70% of the non-volatiles (CI-4, Ln 55-

Art Unit: 1793

60). The pigment comprised of about 4 wt% to 95 wt% by weight of the total non-volatiles (Cl-5, Ln 8-24). The composition further contained solvents, curing agents, suspending agents, plasticizers and the like (Cl-5, Ln 25-31; Cl-8-10, Claims -1, 3-5).

The prior art fails to teach the instant claimed ranges for the Sn and binder.

However, the prior art ranges will overlap with the instant claimed ranges for the Sn and binder in the claims, and in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. <MPEP 2144.05 [R-5]-I>.

2. Claims 155 and 172 are rejected under 35 U.S.C. 103(a) as being obvious over Reising et al (US 6,715,916) in view of either Tsuneta (US 5,213,846) or Matsuda et al (US 3,904,555).

Reising et al teach a coating composition for weldable substrates comprising one or more conductive pigments comprising Al, Zn, **W**, **Graphite** and ferrophos (A/a) with a particle size of ~1 to ~5 microns, preferably ~3 micron, and in the amount of ~30 to ~60 by volume % that will meet the component ratio when calculated in terms of wt%. Graphite makes the conductive particles sliding because of its layered structure. The binder comprised of resins such as epoxy or polyurethane in the amount of ~10 to ~20 wt% (Cl-6, Ln 1-17). The composition further contained crosslinkers such as cymel and/or blocked isocyanates and a solvent and the pigment to binder ratio was ~10 to ~50 wt% (Cl-6, Ln 34-64; Cl-9, Ln 43-48) that meets the ratio limitations the claims. The coating composition further contains hydrogenated or sulfated castor oil and pigments such as magnesium silicate (Cl-7, Ln 4-11). The prior art teaches the composition containing blocked isocyanates, urea-melamine derivatives and tungsten and coating the film over a metal substrate (Cl-5, Ln 45; Cl-6, Ln 39-41; Cl-8, Ln 4-7; Cl-9, Ln 44-49).

The prior art fails to teach the instant claimed Sn or Sn alloy per claim 155 and 172.

In the analogous art, Matsuda et al teach weldable/corrosion-resistant paint composition comprising one or more hard metals selected from Fe, Ni, Co, Cr, Mn and their alloys, one or more soft metals selected from Al, Zn, Pb, Cu, Cd, Mg, Ag, Sn and their alloys (Abstract, Cl-1, Ln 55-63; Cl-3, Ln 1-2), a resin such as epoxy or acrylic dispersed and a solvent (Cl-3, Ln 10-17); and coating galvanized steel

Art Unit: 1793

plate with the composition (Cl-3, Ln 22-26) with improved electroresistance weldability in spite of low metal content and corrosion resistance (Cl-2, Ln 31-33; 42-45; Cl-3, Ln 27-28).

In the analogous art, Tsuneta et al teach corrosion-resistant paint composition comprising a binder such as epoxy, silicate such as silica, graphite and a conductive metal powder selected from Zn, Al, Mg, Fe Ni, Co, Sn, Cu, Cr, Mn or an alloy thereof (Abstract, Cl-5, Ln 1-25) and coating steel plate (Cl-6, Ln 9-11) with improved weldability (Cl-5, Ln 18-22).

It would have been obvious to a person of ordinary skilled in the art to either include or substitute the conductive metal powder in the composition of Reising et al with Sn or its alloy of either Matsuda or Tsuneta et al as functional equivalent to benefit from improved corrosion-resistance/weldability with predictable results and reasonable expectation of success, because the teachings are in the analogous art of weldable/corrosion-resistance coatings for metals and the species of Leon's conductive metal fillers are encompassed by the genus of conductive fillers containing Sn and its alloys.

***Allowable Subject Matter***

Claims 141-154, 156-171, 173-177 are allowed.

The prior art of record neither teaches nor fairly suggest applicant's composition comprising a combination of specific components and their ratios.

Art Unit: 1793

***Response to Arguments***

Applicant's arguments filed 03/02/2009 have been fully considered and in response to the argument claims 155 and 172 were not rejected over prior art, they were indeed rejected over Reising and the rejection over that prior art is maintained. Applicant's TD has been accepted and overcomes the double patenting rejections over copending application with SI. No. 10/511,242.

For the reasons set forth above applicants fail to patentably distinguish their composition over prior art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KALLAMBELLA VIJAYAKUMAR whose telephone number is (571)272-1324. The examiner can normally be reached on M-F 07-3.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 5712721358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KMV/  
June 05, 2009.

/Stanley Silverman/  
Supervisory Patent Examiner, Art Unit 1793